

Remarks

A. Claims in the Case

Claims 1-14, 16-19, and 21-23 have been rejected. Claims 1-14, 16-19, and 21-23 have been cancelled. Claims 24-44 have been added. Claims 24-44 are pending.

B. 35 U.S.C. §102(e) Rejections

The Examiner has rejected claims 22 and 23 under 35 U.S.C. §102(e) as being anticipated by Chung, et al. (U.S. Patent No. 6,643,137) (hereinafter "Chung"). Applicant respectfully disagrees with these rejections, however, as claims 22 and 23 have been cancelled, the rejection is believed moot.

Applicant respectfully notes the standard for "anticipation" is one of fairly strict identity. To anticipate a claim of a patent, a single prior source must contain all the claimed essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 U.S.P.Q.81, 91 (Fed.Cir. 1986); *In re Donahue*, 766 F.2d 531, 226 U.S.P.Q. 619, 621 (Fed.Cir. 1985).

Applicant respectfully notes Chung does not disclose "the biasing element resiliently biases the electrically conductive connection member onto the electrically conductive contact (emphasis added)" as recited in claim 24. The Examiner points to spring 436 of Chung to teach a biasing element but does not specify which element of Chung is a "connection member." Applicant respectfully notes that element 43 of Chung cannot anticipate "connection member" of claim 24 because the spring 436 actually biases the connection member **away** from contacting the contact 42 not "onto" as recited in claim 24. For at least this reason, claim 24 and claims dependent thereon are believed allowable over Chung.

Claim 34, 39, and 42 recite, among others, similar limitations not disclosed, taught, or suggested by Chung. For at least these reasons, claims 34, 39 and 42 and claims dependent thereon are believed allowable over Chung.

Similarly, Chung does not disclose, teach, or suggest at least “the biasing element resiliently biases the first piece and second piece apart to bias the second piece onto the electrically conductive contact (emphasis added)” as recited in claim 44. For at least this reason, claim 44 and claims dependent thereon are also believed allowable over Chung.

C. 35 U.S.C. §103 Rejections

Claims 1-3, 7-14, 16-19 and 21

The Examiner has rejected claims 1-3, 7-14, 16-19 and 21 under 35 U.S.C. §103 as being anticipated by Danovitch, et al. (U.S. Patent No. 6,819,566) (hereinafter “Danovitch”) in view of Chung. Applicant respectfully disagrees with the rejections, but as claims 1-3, 7-14, 16-19 and 21 have been cancelled, the rejection is believed moot.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner* et al., 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

The Office Action has not stated a *prima facie* case of obviousness for combining Danovitch and Chung. As stated in the MPEP §2142:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added)

There is no teaching or suggestion to combine Danovitch and Chung either in the references or in the prior art. Furthermore, Danovitch teaches away from Chung.

Danovitch teaches: "In addition, no pressure is required to be applied between lid 16 and substrate 13 to ensure the compliant member 21 appropriately contacts lid 16 and ground pad 18... (emphasis added) (Danovitch, col. 5, lines 38-41)." In contrast, Chung teaches threaded screw fasteners that apply pressure to the top plate. As stated in MPEP §2141.02: "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)"

Additionally, MPEP §2143.01 states: "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)" Because Chung teaches using threaded fasteners to apply pressure and Danovitch teaches no pressure is required, the Chung modification would make Danovitch unsatisfactory for its intended purpose. Applicant respectfully asserts it would not have been obvious to combine Danovitch and Chung in the manner suggested by the Examiner.

Applicant also respectfully notes, as stated in MPEP §2141: "The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention (emphasis added)." The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), MPEP § 2143.01.

Therefore, Applicant respectfully submits claims 24-44 are allowable over Danovitch and Chung which are not properly combinable.

Claims 4-6

The Examiner has rejected claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Danovitch in view of Chung and further in view of Gonsalves, et al. (U.S. Patent No.

6,212,074) (hereinafter "Gonsalves"). Applicant respectfully disagrees with these rejections, however, as claims 4-6 have been cancelled, the rejection is believed moot.

D. New Claims

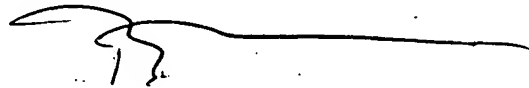
Applicant respectfully asserts the cited art does not disclose, teach, or suggest at least the combination of features in claims 24-44 for at least the above reasons.

E. Summary

Based on the above, Applicant submits that all of the claims are in condition for allowance. Favorable reconsideration is respectfully requested.

If any extension of time is required, Applicant hereby requests the appropriate extension of time. If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel Deposit Account No. 50-1505/5681-78000/BNK.

Respectfully submitted,



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